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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/531,497	03/21/2000	Yusuke Nemoto	6195-0074-2	7101

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EXAMINER

CHAU, MINH H

ART UNIT	PAPER NUMBER
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2854

11

DATE MAILED: 04/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/531,497

Applicant(s)

NEMOTO, YUSUKE

Examiner

Minh H Chau

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 4-9 and 14-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 10-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Species of Figure 1 as readable on Claims 2, 3, 10, 11 and 12 in Paper No. 10 (filed on 01/14/02) is acknowledged. The traversal is on the ground(s) that, Office Action does not provide the reasons indicated the distinct species of the claimed invention, the Office Action also fails to address in any way whether the pending claims recited mutually exclusive characteristics and the grounds that a search and examination of the entire application would not place a serious burden on the Examiner. This is not found persuasive because first of all, MPEP 816 relied upon by the Applicant is directed to restriction requirement practice, not for election of species requirement as in the current application. Secondly, since there are no generic claims present in the application, all claims must be mutually exclusive. Further more, since, for example Fig. 4 show a cleaning unit that is not required in Fig. 1, and the search for these species would require separate searches in different classes and subclasses. Therefore, it would be an undue burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Asano et al. (US # 5,636,929).

With respect to claim 1, Asano et al. teach a printer comprising a printing unit (101), a guide path or a paper-feeding path, a rotating member (40A) disposed in the paper path and contributes to carry the sheet of paper and a removing member (41) which is in contact with the periphery of the rotating member and removes the ink from the rotating member (see Figs. 1-9 and cols. 5-7). With respect to the recitation "rotates so as to spread ink transferred to the rotating member" (lines 9-10), Asano et al. teach that the removing member (41) is in contact with the periphery of the rotating member (40A) (col. 8). In view of this teaching, it is clear to one of ordinary skill in the art that when the removing roller (41) contacts the periphery of the rotating member, it will likely to spread ink transferred to the rotating member.

With respect to claim 2, see Fig. 8 that show a removing member is a removing roller.

With respect to claim 3, see col. 8 that teach the removing roller (41) rotates in accordance with the rotation of the rotating member (4A).

With respect to claim 10, see Fig. 8 that show the rotating member is a pair of resist roller.

With respect to claim 11, see Fig. 24A that show the resist rollers are capable of rotated not only at the time of conveying a printed sheet. It is also noted that the language of this claim are functional, it does not provide any structure to operated the resist rollers.

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kagawa (US # 5,988,061) in view of Asano et al.

Kagawa teach a stencil printer having a master making mechanism, a guide path (45a), a pair of rotating member or resist roller (44). While Kagawa does not teach a removing member, Asano et al. teach a removing member (41) as explained in the above rejection. In view of this teaching, it would have been obvious to one of ordinary skill in the art to modify the stencil printer of Kagawa to include a removing roller as taught by Asano et al. so as to prevent the printed sheet from being smear from the excess ink on the rotating member. It is also noted that the language in claim 12 is purely functional, what structure that provide the rotation of the resist rollers? and what is a connection between the resist rollers that is rotated at the time of master making operated.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Applicant's attention is invited to the patents to Parks (US # 5,163,674) Nakamura et al. (US # 5,719,611) and Ito (JP 10-66705A).

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh H Chau whose telephone number is (703) 305-0298. The examiner can normally be reached on M - TH 9:30AM – 8:00PM


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H Hirshfeld can be reached on (703) 305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5841 for regular communications and (703) 308-5841 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

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MHC

April 8, 2002

  
Dan Colilla  
Primary Examiner  
Art Unit 2854